

## **EXHIBIT 7**



# The Role of the Solicitor's Office

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EXCERPT

# Major Responsibilities of the Solicitor's Office

1. Litigation: Represent the agency in federal court litigation & advise DOJ on I.P. cases where PTO is not a party
2. Advice: Provide legal & policy advice to senior management on complex legal/technical issues
3. OED: Prosecute practitioners who violate OED rules and assist in the administration of the registration exam

## 2. Legal Advice

- Promulgate and implement rules – e.g., proposed rules regarding continuations, claims and IDS
- Guidelines – e.g., 101 guidelines, utility guidelines
- Review petition decisions likely to be litigated
- Review patent/trademark applications raising important or unique legal questions
- Advise on complex policy questions

## Latest Rules Proposals

- Latest rules proposals address (i) continuations, (ii) claims, and (iii) IDS practice (coming soon)
  - Solicitor's Office brought in early
    - Importance of rules to practitioners
    - Anticipated legal challenges
- Minimal impact on majority of cases
- Make examination more focused/efficient
- Reduce effect of atypical cases
- Will also help reduce backlog

## Let's Look at the Numbers

- 384,228 applications filed in fiscal 2005
  - 30,767 were continuations (non-CIP)
  - 6,411 were 2<sup>nd</sup> or higher in a cont chain
- 54,495 Requests for Continued Examination
  - 10,370 were 2<sup>nd</sup> or higher RCEs in a series
- Thus 4-5% of applications (16,781/384,228) have already been through two or more complete examinations

## a. Set reasonable limits on continuation practice

- One continuation or RCE as of right
- For 2<sup>nd</sup> and subsequent continuations
  - Petition and show why it is needed “to obtain consideration of an amendment, argument, or evidence that could not have been submitted” earlier in series
- No first action finals (4 bites at the apple)
- Office-ordered divisionals treated as separate applications

## a. Limits on continuation practice --cont'd

- No voluntary divisionals
  - Presumption of double patenting when two applications
    - Filed same day
    - Same assignee
    - Common inventors
    - Substantial overlap in disclosure
  - Rebut presumption by showing that claims are patentably distinct

## b. Representative Claims

- Patent Board uses Rep Claims
- District Court uses Rep Claims
- CAFC uses Rep Claims
- Examiner and Applicants will use 10 representative claims
  - Consider how much examiner time is wasted when applicants amend all independent claims in response to first office action

## b. Representative Claims –cont'd

- No claim will issue without complete examination!
- Initial examination will focus on 10 representative claims
  - all independent claims
  - others as selected by applicant
  - remaining claims held in abeyance until representative claims ready for allowance
- Applicants who want immediate examination of all claims will have to:
  - Conduct a Search
  - File Examination Support Document showing patentability of all claims over closest art

# Comments and Effective Dates

- Comments accepted until May 3, 2006
  - AB93Comments@uspto.gov (Cont Reform)
  - AB94Comments@uspto.gov (Rep Claims)
- Effective Date of Final Rule
  - Continuation limits apply to any application filed on or after the effective date of the final rule
  - Representative Claims used in all cases without a first office action as of the effective date of final rule

## c. IDS Reform Coming Soon

- Will have little effect on the typical application
- At a certain point applicants will be required to discuss materiality of submitted references, e.g. when
  - Large references (over 30 pages)
  - Lots of references (over 25)
  - References submitted late in the application process

## 2. Legal Advice (cont.)

- Reexamination questions
- Reissue questions
- Interference questions
- Petitions questions

## Summary: Unique Aspects About the Work of the Solicitor's Office

- Involved in both litigation and policy
- Diverse docket
- Work with, and learn from, bright people both within the USPTO and other government agencies.

# Thank You

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